

REMARKS

Summary of the Office Action

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 4,573,625 to Olesen et al. ("Olesen") in view of U.S. Patent No. 6,923,360 to Sesek et al. ("Sesek").

Summary of the Response to the Office Action

Claims 1-4 and 7-11 are presently pending for further consideration. Claims 1 and 7 have been amended. Claims 5 and 6 have been cancelled. New claims 9-11 have been added.

Finality of Office Action

Applicants respectfully assert that the finality of the Office Action dated August 8, 2007 is premature because it introduces a new ground of rejection (U.S. Patent No. 6,923,360 to Sesek ("Sesek")) not necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (See MPEP § 706.07(a).) The only independent claim, claim 1, was not amended in the response to the previous Office Action, but Sesek was introduced as a new basis for rejection. Thus, the rejection was not necessitated by the amendment of dependent claims 2 and 7, with claim 2 amended only to correct a problem with antecedent basis and claim 7 amended to conform to English syntax. Consequently, Applicants respectfully request that the Examiner remove the finality of the Office Action dated August 8, 2007.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olesen in view of Seseck. Applicants respectfully traverse the rejection. of the claims as amended.

Claim 1 has been amended to recite the features of cancelled claim 6 – “a staple guide that guides the connected staples to the striking portion; and a fixed anvil formed at a front end portion of the staple guide.” The Office Action states that there is “a fixed anvil via 100 formed at a front end of the staple guide 102.” Applicants respectfully disagree.

There is nothing in Olesen that can be considered a fixed anvil as recited in claim 1. It is clear from Fig. 9 that only block 60 (alleged in the Office Action to be the moveable anvil of claim 1) is in the path of driver blade 80 and/or former 70 such that it can be considered an anvil. However, block 60 cannot be both a moveable anvil and a fixed anvil. Similarly, Fig. 19 only shows block 60’ in the path of driver blade 80’ and/or former 70’ such that it can be considered an anvil. Cartridge extensions 508 appear in the section view of Fig. 19 to be in the path of driver blade 80’ and/or former 70’, but Fig. 17 clearly shows cartridge extensions 508 to be above and outside of the width of the staple blanks. Thus, cartridge extensions 508 cannot be considered an anvil – fixed or moveable. Thus, Olesen does not disclose or suggest the fixed anvil recited in claim 1.

Seseck also does not disclose a fixed anvil as recited in claim 1. Element 110 of Seseck may be considered analogous to an anvil for forming staples from staple blanks. However, as described, e.g., at col. 5, lines 27-58 of Seseck, the forming anvil first member 112 and second member 132 move toward or away from one another. This is the gist of the invention, moving the anvil members to adjust the length of the legs of the staples. Thus, there is nothing in Seseck

that can be considered the fixed anvil recited in claim 1.

The Office Action continues to cite *In re Hutchison* for the proposition that “recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform [and] does not constitute a limitation in any patentable sense” despite the Response to the previous Office Action explaining that *In re Hutchison* is *dicta* and citing later cases finding that such language serves to precisely define structural attributes of interrelated component parts of the claimed assembly. Applicants respectfully request that the Examiner consider the appropriate caselaw. To quote the MPEP:

A functional limitation is an attempt to define something by what it does, rather than by what is its (e.g., as evidenced by its specific structure or specific ingredients). . . .

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient, or step.

(MPEP § 2173.05(g); emphasis added.) Thus, giving “little consideration” to the feature of “wherein the forming plate is capable of forming the staple member...” is inappropriate and Applicants respectfully request that proper consideration be given to the feature.

Applicants respectfully assert that – absent a fixed anvil as recited in claim 1 – Olesen cannot be modified so that the forming plate is “capable of forming the staple member which is arranged above the movable anvil advanced into the striking path and the staple member which is successive to the staple member above the movable anvil simultaneously in the C-shape” as also recited in claim 1. If Olesen were modified to make the former wide enough to form two staples

at once and there were no fixed anvil, there would be nothing to keep the second staple blank from breaking off as the former came down. If the groove 64 in the former block 60 of Olesen were made deeper to accommodate two staples, the driver blade 80 could either be wide enough to accommodate two staples – in which case it would drive two staples at once into the stacks of paper – or the driver blade could remain at the present width so that one staple would remain permanently in groove 64. In either case, the stapler would not operate properly.

For at least the foregoing reasons, Applicants respectfully assert that claim 1, and its dependent claims 2-4 and 7-11 are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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